

REMARKS

Summary of Office Action

Claims 1-23 were pending in this application.

Claims 1, 2, 6, 13, 14, 18, 22, and 23 were rejected under 35 U.S.C. § 102(e) as being anticipated by LaJoie et al. U.S. Patent No. 5,850,218, issued December 15, 1998 ("LaJoie").

Claims 3-5, 11, 12, 15-17, 20, and 21 were rejected under 35 U.S.C. § 103(a) as being obvious from LaJoie in view of Florin et al. U.S. Patent No. 5,594,509, issued January 14, 1997 ("Florin").

Claims 7-9 and 19 were rejected under 35 U.S.C. § 103(a) as being obvious from LaJoie in view of Alten et al. U.S. Patent No. 5,635,978, issued June 3, 1997 ("Alten").

Claim 10 was rejected under 35 U.S.C. § 103(a) as being obvious from LaJoie in view of Alten and Marshall et al. U.S. Patent No. 5,828,420, issued October 27, 1998. ("Marshall").

Summary of Applicant's Reply

Applicant maintains the position that LaJoie does not show all the features of applicant's independent claims 1 and 13. Furthermore, applicant has amended claims 1, 3-5, 12, 13, 15-17, and 21 to define additional features of the

invention. Claims 24-37 have been added. No new matter has been added and the amendments and new claims are fully supported and justified by the application as originally filed. Claims 2, 11, 14, 20, 22, and 23 have been canceled. Applicant reserves the right to pursue claims 2, 11, 14, 20, 22, and 23 in one or more continuing applications that claims priority to the present application.

Reconsideration of this application in light of the amendments and the following remarks is respectfully requested.

Applicant's Reply to the § 102 Rejections

The Examiner rejected claims 1, 2, 6, 13, 14, 18, 22, and 23 under 35 U.S.C. § 102(e) as being anticipated by LaJoie.

This rejection is respectfully traversed.

Applicant's independent claims 1 and 13 are directed toward a system and method for displaying a pop up window overlaid on a displayed television picture, wherein the television picture is displayed on a substantially full portion of a television monitor. The pop up window includes both an advertising message and an informational message that are related to the displayed television picture. Claims 1 and 13 have been amended to specify that the advertising

message is selected from a plurality of advertising messages that are related to the displayed television picture.

Claims 1 and 13 have been further amended to specify that the informational message is an informational message other than a program title. This is not to say that a program title could not also be displayed.

In making the § 102 rejection of claims 1 and 13, the Examiner points to two separate Figures of LaJoie. First, the Examiner points to LaJoie FIG. 16 as allegedly showing the display of "an advertising message . . . and an informational message [that are] related to . . . [a displayed] television picture" (Office Action, p. 3, ll. 2-5). Implicitly, the Examiner concedes that LaJoie FIG. 16 does not show applicant's claimed feature of displaying the television picture on a "substantially full portion" of a display monitor. To address this deficiency, the Examiner points to LaJoie FIG. 4 as showing this feature (Office Action, p. 3, ll. 6-8).*

Applicant respectfully submits that this § 102 rejection is improper. The law states that § 102

* In particular, the Examiner contends that "[t]he 'substantially full portion' limitation on the means for displaying the television picture on the monitor is met by LaJoie et al's disclosure in FIG. 4 (100, 106, 108)" (Office Action, p. 3, ll. 5-7).

"[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (*Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485; emphasis added). The Examiner's § 102 rejection here does not meet this requirement. In particular, as described above, LaJoie FIG. 16 does not display television picture 340 on a "substantially full portion" of a display monitor. Therefore, this portion of LaJoie does not show each and every element of the claimed invention, arranged as in the claims. In fact, by looking to television picture (100, 106, 108) of LaJoie FIG. 4 to show applicant's claimed feature of displaying a television picture on "substantially full portion" of a display, the Examiner has effectively engaged in a § 103 analysis in what is labeled as a § 102 rejection. In particular, the Examiner has suggested that it would be obvious to modify the LaJoie FIG. 16 display to include the "substantially full portion" feature of the FIG. 4 display. However, even if this § 103 rejection were made in this case, this rejection would fail because the Office Action fails to point to any objective motivation in LaJoie which would lead one of ordinary skill in the art to make such a modification. Notably, the LaJoie

FIG. 4 and FIG. 16 displays relate to different display modes of the LaJoie system -- i.e., the FIG. 16 display relates to the display of a program grid (col. 13, ll. 44-51), whereas the FIG. 4 display relates to a program information banner that is displayed as the user changes channels (col. 15, ll. 12-23).*

Accordingly, because LaJoie does not show each and every feature of applicant's independent claims, arranged as in the claims, the § 102 rejections of claims 1, 2, 6, 13, 14, 18, 22, and 23 in view LaJoie should be withdrawn.

Applicant respectfully submits that the § 102 rejections should be withdrawn for at least the additional, independent reason that LaJoie does not show applicant's claimed feature of "selecting an advertising message related to a displayed television picture from a plurality of advertising messages related to the displayed television picture." For example, applicant's specification describes that "advertising messages could [be displayed that] promote the products or services of the television program sponsor" (p. 12, ll.34-35). Furthermore, advertisement "[a]rea 16 [of FIG. 1] is variable in the sense that different

* Applicant reserves the right to provide additional reasons why there is no motivation to modify the LaJoie FIG. 16 display in view of the LaJoie FIG. 4 display at a later stage if necessary.

advertisements are displayed therein" (p. 13, ll. 15-16). In one example, "a different advertisement could be provided on a rotational basis each time the browse or grazing mode is initiated" (p. 13, ll. 17-19). In another example, "a different advertisement could be displayed after a predetermined time according to a prescribed cycle of advertisements" (p. 13, ll. 19-20).

In the Office Action, the Examiner contends that the "channel's identification and logo" in area 344 of FIG. 16 shows an advertisement related to television picture 340 (Office Action, p. 3, ll. 3-4). However, this channel identification and logo of area 344 are invariably displayed whenever video for the corresponding channel is displayed in area 340 (LaJoie, col. 23, ll. 63-66). In other words, the LaJoie channel identification and logo are not "select[ed] . . . from a plurality of advertising messages related to the displayed television picture," as required by applicant's independent claims 1 and 13.**

The foregoing demonstrates that LaJoie does not disclose all of the features of applicant's independent

** Applicant reserves the right to provide at a later stage if necessary additional reasons why the LaJoie FIG. 16 display of a channel identification and logo in area 344 does not show applicant's claimed feature of "selecting an advertisement . . . from a plurality of advertisements related to the displayed television picture."

claims 1 and 13. Therefore, the § 102 rejections of independent claims 1 and 13 and corresponding dependent claims 6 and 18 in view of LaJoie should be withdrawn.

Applicant's Reply to the § 103 Rejections

The Examiner rejected claims 3-5, 7-10, 12, 15-17, 19, and 21 under 35 U.S.C. § 103(a) as being obvious from LaJoie in view of one or more of Florin, Alten, and Marshall. All of claims 3-5, 7-10, 12, 15-17, 19, and 21 depend either directly or indirectly from independent claims 1 and 13. As set forth by applicant in the previous section, claims 1 and 13 are allowable over LaJoie. Therefore, dependent claims 3-5, 7-10, 12, 15-17, 19, and 21 are allowable over LaJoie for at least the reasons that independent claims 1 and 13 are allowable over LaJoie. Accordingly, the § 103 rejections of claims 3-5, 7-10, 12, 15-17, 19, and 21 should be withdrawn.

Conclusion

The foregoing demonstrates that claims 1, 3-10, 12, 13, 15-19, 21, and 24-37 are allowable. This application is therefore in condition for allowance. Reconsideration and

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allowance of this application are accordingly respectfully
requested.

Respectfully submitted,



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